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November 15, 2012

**TTAB**

US Patent & Trademark Office  
Trademark Trial & Appeal Board  
P. O. Box 1451  
Alexandria, VA 22313-1451

**RE: Application of Perry David Merlo**  
**Serial No. 85510114**

Dear Sir or Madam:

Enclosed please find the original and three copies of Applicant's Brief In Re Application of Perry David Merlo.

If you have any questions or concerns, please feel free to contact me.

Thank you.

Very truly yours,

Perry D. Merlo

PDM/djs  
Enclosures



\*11-19-2012\*

U.S. Patent and Trademark Office #72

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**TRADEMARK TRIAL and APPEAL BOARD**

In re application of Perry David Merlo

Serial No.: 85510114

Application date: 1/6/2012

Appeal date: 9/24/2012

Examining Attorney: Robert J. Struck, esq.

**APPLICANT'S BRIEF**

**I. STATEMENT OF RELATED CASES**

There are no related cases.

**II. STATEMENT OF THE ISSUES**

1. Whether the applied for mark "MERLO'S MERLOT" is likely to cause confusion vis-a-vis the registered mark "LAGO DI MERLO".

2. Whether the applied for mark “MERLO’S MERLOT” is primarily a surname.

### **III. STATEMENT OF THE FACTS AND PROCEDURAL HISTORY**

Applicant filed to register the mark “Merlo’s Merlot” on or about January 6, 2012, without any claim to any particular font, style, size or color, on the Principal Register for “Grape wine, Red wine”. The examining attorney for the USPTO issued an Office Action and Final Action on April 19, 2012 and May 17, 2012, respectively, refusing registration of the mark. The Applicant thereafter filed a timely appeal to this Board requesting reversal of the examining attorney’s decision.

### **IV. SUMMARY OF THE ARGUMENT**

Even though the goods being compared are identical, the remaining du Pont factors lead to the conclusion that there is no likelihood of confusion. The dissimilarities between the two marks, when compared as a whole, are so significant as to cause no confusion. The marks each contain no identical words, sound dissimilar, and have different meanings. Furthermore, the fame of the registered mark is hardly overwhelming as there is no evidence as to the public’s recognition of the registered mark and the fact that the registered mark is contained in a website is not uncommon. The dominate word in the applicant’s mark is “Merlot” as the weaker word “Merlo’s” describes the word “Merlot”. The dominate word and more distinctive word in the registered mark is “Lago”. As well, there is no evidence of actual confusion.

The Applicant's mark is not primarily a surname. The name describes a type of wine. Infact, no where in the applied for mark is a surname solely used. The mark contains two words "Merlo's Merlot" neither of which, standing together or alone, are surnames. As well, the word Merlo is translated from Italian to English as "blackbird".

## **V. ARGUMENT**

### **A. NO LIKLIHOOD OF CONFUSION**

Each application for a trademark must be considered on its own merits and not based upon prior applications involving different facts. In re Nett Designs, Inc., 236 F.3d 1339 (Fed Cir. 2001). In this case, this Board's analysis of the issue of likelihood of confusion begins with the thirteen relevant factors set forth in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 USPQ (BNA) 563 (1973). The Applicant argues that the first DuPont factor, the similarity or dissimilarity between the registered and applied for mark, is most relevant and controlling in this case. Specifically, the marks differ in their appearance, sound, connotation and commercial impression. The registered mark "Lago di Merlo" is not similar to the applied for mark "Merlo's Merlot". No identical words appear in either mark. The one mark has three words, the other two, and all are spelled differently. The English translation of the marks is also disparate; "Lago Di Merlo" translates to English as "Lake Merlo" or "Lake of Merlo" (See Italian to English translation from Babylon attached hereto as Exhibit "A".) "Merlo's Merlot" translates to "Merlo's Blackbird"; the Italian word for "blackbird" being "Merlot". (See English to Italian translation from Babylon attached hereto as Exhibit "B") As such, the likelihood of confusion

between the two marks is not great as neither mark contains identical words, only one similar sounding word (“Merlo” vs. “Merlo’s”) and two distinctly different words : “Lago, and Di ”.

The Applicant further submits that the differences between the applied for and registered marks are much greater than marks which were rejected for protection such as:

“Thinker toys” (registered mark “Tinkertoys”). CBS, Inc. v. Morrow, 708 F.2d 1579, 218 U.S.P.Q. (BNA) 198 (Fed. Cir. 1983);

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The Applicant argues that its mark is just as distinctive if not more distinctive than other marks which were afforded trademark status with more similar names than the instant applied for mark and the registered trademark which also were selling the same products :

“Torre Muga” (registered mark “Gran Torres” (both selling wine)). Miguel Torres, S.A. v. Bodegas Muga, S.A., 2005 TTAB LEXIS 243 (2005);

“Capital City Bank” (registered mark “Citibank” (both banks)) Citigroup Inc., v. Capital City Bank Group, Inc., 637 F.3d 1344, 98 USPQ2d (BNA) 1253 (2001).

A consumer would NOT surmise that “Merlo’s Merlot” has any association with “Lago Di Merlo” and the examining attorney’s argument to the contrary is not supported by any caselaw.

#### **B. THE APPLICANT’S MARK IS NOT MERELY A SURNAME**

The PTO has the burden of establishing a prima facie case that Merlo’s Merlot is primarily a surname. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Moreover, the question of whether a mark sought to be registered is primarily merely a surname within the meaning of the statute can be resolved only on a case by case basis taking into account a number of factual considerations. Id. Specifically, there are five factors which are relevant to a determination of whether a mark would be perceived as primarily a surname:

1. The degree of the surname’s rareness;
2. Whether anyone connected with the applicant has the surname;
3. Whether the mark has any recognized meaning other than that of a surname;
4. Whether the mark has the structure and pronunciation of a surname;

5. Whether the surname, when coupled with a distinctive design, is distinctive enough to create a separate non-surname impression. In re Benthin Management GmbH, 37 USPQ2d (BNA) 1332 (1995); In re Gregory, 70 USPQ2d (BNA) 1792 (2004).

In regards to the first factor, the Applicant concedes that the word Merlo is located in phone directories, but does not concede that it is a common name. The examining attorney's search reveals that the name Merlo is only found 866 times in a nationwide telephone directory of names. As well, the rarity of a surname is not, in and of itself, dispositive of the issue of whether a mark is primarily a surname. In re Rebo High Definition Studio Inc., 15 USPQ2d 1314 (TTAB 1990). More importantly, however, is the fact that the applied for mark is not the word "Merlo". The applied for mark is "Merlo's Merlot". No proof, whatsoever, has been submitted by the examining attorney as to the words "Merlot's Merlo" being a name, surname or otherwise, in any telephone directory. "A mark must be considered in its entirety" and it is an error to dissect marks. In re Standard Elektrik Lorenz Aktiengesellschaft, 54 CCPA 1043, 371 F.2d 870 (1967). *See also* Ada Milling Co., 40 CCPA 1076, 205 F.2d 315 (1953) where the Court reversed the Patent office's refusal to register the word "Startgrolay" holding that it was improper to separate the words in the mark as the mark was to be viewed in its entirety. Similarly, in In re Hutchinson Technology Inc., 852 F.2d 552, 7 USPQ2D (BNA) 1490 (1988) the Court held that it was an error for the PTO to dissect the words *Hutchinson Technology*.

*...[A] mark sought to be registered must be considered in its entirety. The board considered the mark as two separate parts, 'Hutchinson' and 'technology', and analyzed the registrability of each word separately....[T]he fatal flaw in the board's analysis is that the mark sought to be registered is not HUTCHINSON or TECHNOLOGY, but HUTCHINSON TECHNOLOGY. The board never considered what the purchasing public would think when confronted with the mark as a whole* Id. at 852 F.2d at 554.

Here, the examining attorney cites only part of the mark (Merlo) as being listed in telephone directories by use of dissection and the same is in error. Absolutely no evidence has been submitted by the examining attorney which supports a conclusion that “Merlo’s Merlot” is a surname.

In regard to the second factor, the Applicant concedes that his last name is Merlo, however, “Merlo” is not the applied for mark; “Merlo’s Merlot” is the applied for mark.

Concerning the third factor, the Applicant does not concede that the word “Merlo” has no other meaning than that of a surname as the Italian translation of the word “Merlo” is “Blackbird”.  
(See Exhibit “B”).)

In this case, the forth and fifth factors are most relevant as to the determination of whether the mark is primarily a surname. The Applicant does not seek to register “Merlo” per se. Rather, Applicant seeks to register “Merlo’s Merlot”. As such, the Applicant seeks to register a combination of the terms “Merlo’s” and “Merlot”. Standing alone, the word “Merlo” can be considered primarily a surname, however, when used in its plural form and when coupled with the word “Merlot” the mark is not primarily a surname nor does it have the structure and sound of a last name. In re Industrie Pirelli, 9 USPQ2d 1564, 1566 (TTAB 1988). In cases where merely stylization of a surname was enough to conclude that an applicant’s mark was not merely a surname, here, as well, the combination of the two words “Merlo’s Merlot” creates such a distinction as to render it not merely a surname. Benthin, *supra*. Here a secondary meaning of



what otherwise would be merely a surname has been presented by the Applicant; the surname does not stand alone. *See In re Pickett Hotel Co.*, 229 USPQ 760, 763 (TTAB 1986).

The Applicant also submits that the applied for mark has meaning other than merely a surname attached to a generic term. *In re Hamilton Pharmaceuticals, Ltd.*, 27 USPQ2d (BNA) (1939). The Applicant concedes that if it were asking that trademark status be giving to “Merlo’s Riesling” or “Merlo’s Chardonnay” these would be arguably merely surnames and generic terms. However, the applied for mark is “Merlo’s Merlot” and has a unique meaning above and beyond merely a surname and a generic term. It could be interpreted in Italian as “Blackbird’s Blackbird”; as “Merlo’s Blackbird”; as “Blackbird’s Merlot” or Merlo’s Merlot none of which have any specific meaning other than a play on two similarly sounding words which sound the same and are interchangeable. *See In re Woolley’s Petite Suites*, 18 USPQ2d (BNA) 1810 (1991) and *In re Pickett*, *supra*. Because the terms used in the Applicant’s mark could be merely descriptive words (Merlo / Merlot), taken together, they are not merely a surname.

## **VI. CONCLUSION**

There is no doubt that the registered mark “Lago di Merlo” is distinguishable from the applied for mark “Merlo’s Merlot” so as to cause no confusion with the public. The marks sound different, have different meanings, different translations to and from Italian, are spelled differently and have no identical words. As well, the applied for mark “Merlo’s Merlot” is not merely a surname when considered in its entirety. The mark has a unique meaning beyond that of simply a surname. The Applicant respectfully requests, therefore, that the examining attorney’s decision to deny registration be overturned.



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Even though the goods being compared are identical, the remaining du Pont factors lead to the conclusion that there is no likelihood of confusion. The dissimilarities between the two marks, when compared as a whole, are so significant as to cause no confusion. The marks each contain no identical words, sound dissimilar, and have different meanings. Furthermore, the fame of the registered mark is hardly overwhelming as there is no evidence as to the public’s recognition of the registered mark and the fact that the registered mark is contained in a website is not uncommon. The dominate word in the applicant’s mark is “Merlot” as the weaker word “Merlo’s” describes the word “Merlot”. The dominate word and more distinctive word in the registered mark is “Lago”. As well, there is no evidence of actual confusion.

The Applicant's mark is not primarily a surname. The name describes a type of wine. Infact, no where in the applied for mark is a surname solely used. The mark contains two words "Merlo's Merlot" neither of which, standing together or alone, are surnames. As well, the word Merlo is translated from Italian to English as "blackbird".

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between the two marks is not great as neither mark contains identical words, only one similar sounding word (“Merlo” vs. “Merlo’s”) and two distinctly different words : “Lago, and Di ”.

The Applicant further submits that the differences between the applied for and registered marks are much greater than marks which were rejected for protection such as:

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“Capital City Bank” (registered mark “Citibank” (both banks)) Citigroup Inc., v. Capital City Bank Group, Inc., 637 F.3d 1344, 98 USPQ2d (BNA) 1253 (2001).

A consumer would NOT surmise that “Merlo’s Merlot” has any association with “Lago Di Merlo” and the examining attorney’s argument to the contrary is not supported by any caselaw.

#### **B. THE APPLICANT’S MARK IS NOT MERELY A SURNAME**

The PTO has the burden of establishing a prima facie case that Merlo’s Merlot is primarily a surname. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Moreover, the question of whether a mark sought to be registered is primarily merely a surname within the meaning of the statute can be resolved only on a case by case basis taking into account a number of factual considerations. Id. Specifically, there are five factors which are relevant to a determination of whether a mark would be perceived as primarily a surname:

1. The degree of the surname’s rareness;
2. Whether anyone connected with the applicant has the surname;
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In regards to the first factor, the Applicant concedes that the word Merlo is located in phone directories, but does not concede that it is a common name. The examining attorney's search reveals that the name Merlo is only found 866 times in a nationwide telephone directory of names. As well, the rarity of a surname is not, in and of itself, dispositive of the issue of whether a mark is primarily a surname. In re Rebo High Definition Studio Inc., 15 USPQ2d 1314 (TTAB 1990). More importantly, however, is the fact that the applied for mark is not the word "Merlo". The applied for mark is "Merlo's Merlot". No proof, whatsoever, has been submitted by the examining attorney as to the words "Merlot's Merlo" being a name, surname or otherwise, in any telephone directory. "A mark must be considered in its entirety" and it is an error to dissect marks. In re Standard Elektrik Lorenz Aktiengesellschaft, 54 CCPA 1043, 371 F.2d 870 (1967). *See also* Ada Milling Co., 40 CCPA 1076, 205 F.2d 315 (1953) where the Court reversed the Patent office's refusal to register the word "Startgrolay" holding that it was improper to separate the words in the mark as the mark was to be viewed in its entirety. Similarly, in In re Hutchinson Technology Inc., 852 F.2d 552, 7 USPQ2D (BNA) 1490 (1988) the Court held that it was an error for the PTO to dissect the words *Hutchinson Technology*.

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Here, the examining attorney cites only part of the mark (Merlo) as being listed in telephone directories by use of dissection and the same is in error. Absolutely no evidence has been submitted by the examining attorney which supports a conclusion that “Merlo’s Merlot” is a surname.

In regard to the second factor, the Applicant concedes that his last name is Merlo, however, “Merlo” is not the applied for mark; “Merlo’s Merlot” is the applied for mark.

Concerning the third factor, the Applicant does not concede that the word “Merlo” has no other meaning than that of a surname as the Italian translation of the word “Merlo” is “Blackbird”.  
(See Exhibit “B”).

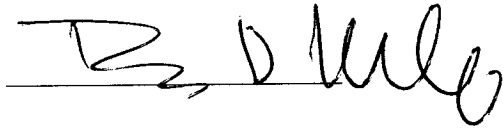
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## **VI. CONCLUSION**

There is no doubt that the registered mark “Lago di Merlo” is distinguishable from the applied for mark “Merlo’s Merlot” so as to cause no confusion with the public. The marks sound different, have different meanings, different translations to and from Italian, are spelled differently and have no identical words. As well, the applied for mark “Merlo’s Merlot” is not merely a surname when considered in its entirety. The mark has a unique meaning beyond that of simply a surname. The Applicant respectfully requests, therefore, that the examining attorney’s decision to deny registration be overturned.

A handwritten signature in black ink, appearing to read "Perry D. Merlo", written over a horizontal line.

Perry D. Merlo, Applicant

November 15, 2012



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、 The Applicant's mark is not primarily a surname. The name describes a type of wine. Infact, no where in the applied for mark is a surname solely used. The mark contains two words "Merlo's Merlot" neither of which, standing together or alone, are surnames. As well, the word Merlo is translated from Italian to English as "blackbird".

## **V. ARGUMENT**

### **A. NO LIKLIHOOD OF CONFUSION**

Each application for a trademark must be considered on its own merits and not based upon prior applications involving different facts. In re Nett Designs, Inc., 236 F.3d 1339 (Fed Cir. 2001). In this case, this Board's analysis of the issue of likelihood of confusion begins with the thirteen relevant factors set forth in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 USPQ (BNA) 563 (1973). The Applicant argues that the first DuPont factor, the similarity or dissimilarity between the registered and applied for mark, is most relevant and controlling in this case. Specifically, the marks differ in their appearance, sound, connotation and commercial impression. The registered mark "Lago di Merlo" is not similar to the applied for mark "Merlo's Merlot". No identical words appear in either mark. The one mark has three words, the other two, and all are spelled differently. The English translation of the marks is also disparate; "Lago Di Merlo" translates to English as "Lake Merlo" or "Lake of Merlo" (See Italian to English translation from Babylon attached hereto as Exhibit "A".) "Merlo's Merlot" translates to "Merlo's Blackbird"; the Italian word for "blackbird" being "Merlot". (See English to Italian translation from Babylon attached hereto as Exhibit "B") As such, the likelihood of confusion

between the two marks is not great as neither mark contains identical words, only one similar sounding word (“Merlo” vs. “Merlo’s”) and two distinctly different words : “Lago, and Di ”.

The Applicant further submits that the differences between the applied for and registered marks are much greater than marks which were rejected for protection such as:

“Thinker toys” (registered mark “Tinkertoys”). CBS, Inc. v. Morrow, 708 F.2d 1579, 218 U.S.P.Q. (BNA) 198 (Fed. Cir. 1983);

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“Delta Café” (registered mark “Delta”). In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d (BNA) 1531 (1997);

“Trevive” (registered mark “Tresemme”). Han Beuty, Inc. v. Alberto Culver Co., 236 F.3d 1333, 57 USPQ2d (BNA) 1557 (2001);

“Crossword Companion” (stylized) (registered mark “Crossword Companion”). Herbko Intl., Inc., v. Kappa Books, Inc., 308 F.3d 1156, 64 USPQ2d (BNA) 1375 (2002);

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“Binion” (registered mark “Binion’s Roadhouse”). In re Jack Binion, 2009 TTAB LEXIS 701; 93 USPQ2d (BNA) 1531 (2009).

The Applicant argues that its mark is just as distinctive if not more distinctive than other marks which were afforded trademark status with more similar names than the instant applied for mark and the registered trademark which also were selling the same products :

“Torre Muga” (registered mark “Gran Torres” (both selling wine)). Miguel Torres, S.A. v. Bodegas Muga, S.A., 2005 TTAB LEXIS 243 (2005);

“Capital City Bank” (registered mark “Citibank” (both banks)) Citigroup Inc., v. Capital City Bank Group, Inc., 637 F.3d 1344, 98 USPQ2d (BNA) 1253 (2001).

A consumer would NOT surmise that “Merlo’s Merlot” has any association with “Lago Di Merlo” and the examining attorney’s argument to the contrary is not supported by any caselaw.

#### **B. THE APPLICANT’S MARK IS NOT MERELY A SURNAME**

The PTO has the burden of establishing a prima facie case that Merlo’s Merlot is primarily a surname. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Moreover, the question of whether a mark sought to be registered is primarily merely a surname within the meaning of the statute can be resolved only on a case by case basis taking into account a number of factual considerations. Id. Specifically, there are five factors which are relevant to a determination of whether a mark would be perceived as primarily a surname:

1. The degree of the surname’s rareness;
2. Whether anyone connected with the applicant has the surname;
3. Whether the mark has any recognized meaning other than that of a surname;
4. Whether the mark has the structure and pronunciation of a surname;

5. Whether the surname, when coupled with a distinctive design, is distinctive enough to create a separate non-surname impression. In re Benthin Management GmbH, 37 USPQ2d (BNA) 1332 (1995); In re Gregory, 70 USPQ2d (BNA) 1792 (2004).

In regards to the first factor, the Applicant concedes that the word Merlo is located in phone directories, but does not concede that it is a common name. The examining attorney's search reveals that the name Merlo is only found 866 times in a nationwide telephone directory of names. As well, the rarity of a surname is not, in and of itself, dispositive of the issue of whether a mark is primarily a surname. In re Rebo High Definition Studio Inc., 15 USPQ2d 1314 (TTAB 1990). More importantly, however, is the fact that the applied for mark is not the word "Merlo". The applied for mark is "Merlo's Merlot". No proof, whatsoever, has been submitted by the examining attorney as to the words "Merlot's Merlo" being a name, surname or otherwise, in any telephone directory. "A mark must be considered in its entirety" and it is an error to dissect marks. In re Standard Elektrik Lorenz Aktiengesellschaft, 54 CCPA 1043, 371 F.2d 870 (1967). *See also* Ada Milling Co., 40 CCPA 1076, 205 F.2d 315 (1953) where the Court reversed the Patent office's refusal to register the word "Startgrolay" holding that it was improper to separate the words in the mark as the mark was to be viewed in its entirety. Similarly, in In re Hutchinson Technology Inc., 852 F.2d 552, 7 USPQ2D (BNA) 1490 (1988) the Court held that it was an error for the PTO to dissect the words *Hutchinson Technology*.

*...[A] mark sought to be registered must be considered in its entirety. The board considered the mark as two separate parts, 'Hutchinson' and 'technology', and analyzed the registrability of each word separately....[T]he fatal flaw in the board's analysis is that the mark sought to be registered is not HUTCHINSON or TECHNOLOGY, but HUTCHINSON TECHNOLOGY. The board never considered what the purchasing public would think when confronted with the mark as a whole* Id. at 852 F.2d at 554.



Here, the examining attorney cites only part of the mark (Merlo) as being listed in telephone directories by use of dissection and the same is in error. Absolutely no evidence has been submitted by the examining attorney which supports a conclusion that “Merlo’s Merlot” is a surname.

In regard to the second factor, the Applicant concedes that his last name is Merlo, however, “Merlo” is not the applied for mark; “Merlo’s Merlot” is the applied for mark.

Concerning the third factor, the Applicant does not concede that the word “Merlo” has no other meaning than that of a surname as the Italian translation of the word “Merlo” is “Blackbird”.  
(See Exhibit “B”).

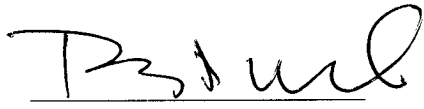
In this case, the forth and fifth factors are most relevant as to the determination of whether the mark is primarily a surname. The Applicant does not seek to register “Merlo” per se. Rather, Applicant seeks to register “Merlo’s Merlot”. As such, the Applicant seeks to register a combination of the terms “Merlo’s” and “Merlot”. Standing alone, the word “Merlo” can be considered primarily a surname, however, when used in its plural form and when coupled with the word “Merlot” the mark is not primarily a surname nor does it have the structure and sound of a last name. In re Industrie Pirelli, 9 USPQ2d 1564, 1566 (TTAB 1988). In cases where merely stylization of a surname was enough to conclude that an applicant’s mark was not merely a surname, here, as well, the combination of the two words “Merlo’s Merlot” creates such a distinction as to render it not merely a surname. Benthin, *supra*. Here a secondary meaning of

what otherwise would be merely a surname has been presented by the Applicant; the surname does not stand alone. *See In re Pickett Hotel Co.*, 229 USPQ 760, 763 (TTAB 1986).

The Applicant also submits that the applied for mark has meaning other than merely a surname attached to a generic term. *In re Hamilton Pharmaceuticals, Ltd.*, 27 USPQ2d (BNA) (1939). The Applicant concedes that if it were asking that trademark status be giving to “Merlo’s Riesling” or “Merlo’s Chardonnay” these would be arguably merely surnames and generic terms. However, the applied for mark is “Merlo’s Merlot” and has a unique meaning above and beyond merely a surname and a generic term. It could be interpreted in Italian as “Blackbird’s Blackbird”; as “Merlo’s Blackbird”; as “Blackbird’s Merlot” or Merlo’s Merlot none of which have any specific meaning other than a play on two similarly sounding words which sound the same and are interchangeable. *See In re Woolley’s Petite Suites*, 18 USPQ2d (BNA) 1810 (1991) and *In re Pickett*, *supra*. Because the terms used in the Applicant’s mark could be merely descriptive words (Merlo / Merlot), taken together, they are not merely a surname.

## **VI. CONCLUSION**

There is no doubt that the registered mark “Lago di Merlo” is distinguishable from the applied for mark “Merlo’s Merlot” so as to cause no confusion with the public. The marks sound different, have different meanings, different translations to and from Italian, are spelled differently and have no identical words. As well, the applied for mark “Merlo’s Merlot” is not merely a surname when considered in its entirety. The mark has a unique meaning beyond that of simply a surname. The Applicant respectfully requests, therefore, that the examining attorney’s decision to deny registration be overturned.

A handwritten signature in black ink, appearing to read "Perry D. Merlo", written over a horizontal line.

Perry D. Merlo, Applicant

November 15, 2012



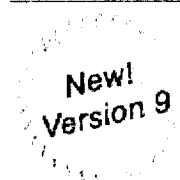
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**TRADEMARK TRIAL and APPEAL BOARD**

In re application of Perry David Merlo

Serial No.: 85510114

Application date: 1/6/2012

Appeal date: 9/24/2012

Examining Attorney: Robert J. Struck, esq.

**APPLICANT'S BRIEF**

**I. STATEMENT OF RELATED CASES**

There are no related cases.

**II. STATEMENT OF THE ISSUES**

1. Whether the applied for mark "MERLO'S MERLOT" is likely to cause confusion vis-a-vis the registered mark "LAGO DI MERLO".



2. Whether the applied for mark “MÉRLO’S MERLOT” is primarily a surname.

### **III. STATEMENT OF THE FACTS AND PROCEDURAL HISTORY**

Applicant filed to register the mark “Merlo’s Merlot” on or about January 6, 2012, without any claim to any particular font, style, size or color, on the Principal Register for “Grape wine, Red wine”. The examining attorney for the USPTO issued an Office Action and Final Action on April 19, 2012 and May 17, 2012, respectively, refusing registration of the mark. The Applicant thereafter filed a timely appeal to this Board requesting reversal of the examining attorney’s decision.

### **IV. SUMMARY OF THE ARGUMENT**

Even though the goods being compared are identical, the remaining du Pont factors lead to the conclusion that there is no likelihood of confusion. The dissimilarities between the two marks, when compared as a whole, are so significant as to cause no confusion. The marks each contain no identical words, sound dissimilar, and have different meanings. Furthermore, the fame of the registered mark is hardly overwhelming as there is no evidence as to the public’s recognition of the registered mark and the fact that the registered mark is contained in a website is not uncommon. The dominate word in the applicant’s mark is “Merlot” as the weaker word “Merlo’s” describes the word “Merlot”. The dominate word and more distinctive word in the registered mark is “Lago”. As well, there is no evidence of actual confusion.

The Applicant's mark is not primarily a surname. The name describes a type of wine. Infact, no where in the applied for mark is a surname solely used. The mark contains two words "Merlo's Merlot" neither of which, standing together or alone, are surnames. As well, the word Merlo is translated from Italian to English as "blackbird".

## **V. ARGUMENT**

### **A. NO LIKLIHOOD OF CONFUSION**

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Perry D. Merlo, Applicant

November 15, 2012





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